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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,347	02/12/2004	Lena Sojian	SLA1473	5085
7590 Gerald W. Maliszewski P.O. Box 270829 San Diego, CA 92198-2829				
EXAMINER DULANEY, BENJAMIN O				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/777,347

Applicant(s)

SOJIAN ET AL.

Examiner

BENJAMIN O. DULANEY

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-21 and 23-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5, 7-21 and 23-31 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments, filed 9/21/08, with respect to the rejection(s) of claim(s) 1 and 17 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. patent 6,919,967 by Pentecost et al. and U.S. patent 5,959,743 by Tanaka.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1) Claims 1-5, 7-11, 17-21 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,919,967 by Pentecost et al., and further in view of U.S. patent 5,959,743 by Tanaka.
- 2) Regarding claims 1 and 17, Pentecost teaches in a multifunctional peripheral (MFP) (column 6, line 5; figure 1, item 18), a text overlaying method comprising: accepting a document; converting the document to rasterized data (Pentecost teaches various techniques to rasterize data, one example is the rasterizing of static data in column 8, lines 41-42); generating a first image (column 8, lines 42-43; rasterizing the data creates a raster image file such as the static page layout object transmitted to

DMU 50); in a print pipeline, accepting an electronically formatted text overlay message (column 8, lines 53-54; static data [first image data] and variable data [second image data, overlay message] are both submitted from a host PC into a print pipeline); converting the overlay message to a page description language (PDL) file (MDPP 48 as taught in column 6, lines 65-67 turns variable data into an "optimized form", a "form" being PDL data as taught in column 5, lines 17-19); processing the PDL file as a print job; and generating a second image as rasterized data (column 8, lines 53-54; variable PDL data is rasterized); merging the first image with the second image; and, creating a merged document (column 8, lines 55-64).

Pentecost does not specifically teach in a copier pipeline, accepting a document.

Tanaka teaches in a copier pipeline, accepting a document (figure 8; column 6, lines 15-20; copier pipeline is defined in applicant's specification as data gained from a scanner, data such as image data gained from scanner unit 100).

Pentecost and Tanaka are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Tanaka to add a second pipeline of data from a scanner. The motivation for doing so would have been to have "an image processing apparatus with an image overlaying mechanism by which image data from an inputting means source are overlaid with image data stored in memory" (abstract). Therefore it would have been obvious to combine Pentecost with Tanaka to obtain the invention as specified by claims 1 and 17.

NOTE: The merge unit of Pentecost (DMU 50) would not function differently because of the combination above, it takes two inputs and merges them together, it would not matter that the inputs are no longer from the same original file as taught by Pentecost, they could still be merged pixel by pixel.

- 3) Regarding claims 2 and 18, Pentecost teaches the method of claim 1 further comprising: creating a paper media merged document (column 8, line 62).
- 4) Regarding claims 3 and 19, Pentecost teaches the method of claim 1 wherein accepting a document includes accepting a document selected from the group including paper media and electronically formatted documents (column 7, lines 40-42; pages from an application are electronic).
- 5) Regarding claims 4 and 20, Pentecost teaches the method of claim 3 wherein accepting an electronically formatted document includes accepting a document selected from the group including text and image documents (column 5, lines 9-16).
- 6) Regarding claims 5 and 21, Pentecost teaches the method of claim 1 further comprising: electronically transmitting the merged document (column 8, lines 59-62; transmitted from DMU to print engine).
- 7) Regarding claims 7 and 23, Pentecost teaches the method of claim 1 wherein creating the merged document includes generating a third image (column 8, lines 54-60).
- 8) Regarding claim 8, Pentecost teaches the method of claim 7 wherein printing the merged document includes sending the third image to an MFP print engine (column 8, line 61).

9) Regarding claims 9 and 24, Pentecost teaches the method of claim 1 wherein converting the overlay message to a PDL file includes converting the overlay message to a PDL file selected from the group including Printer Control Language (PCL) and PostScript (PS) (column 6, lines 8 and 9).

10) Regarding claims 10 and 25, Pentecost teaches the method of claim 1 wherein merging the second image with the first image includes accepting position commands for positioning the second image with respect to the first image (column 11, lines 18-25).

11) Regarding claims 11 and 26, Pentecost teaches the method of claim 10 wherein merging the second image with the first image includes accepting message characteristics selection commands chosen from the group including message size, message shape, font, color, and print options (column 9, lines 18-30).

12) Regarding claims 12 and 27, Pentecost does not specifically teach the method of claim 11 wherein accepting message characteristics selection commands includes: supplying user interface (UI) message characterization prompts at an MFP front panel; and, accepting user commands from the UI.

Tanaka teaches the method of claim 11 wherein accepting message characteristics selection commands includes: supplying user interface (UI) message characterization prompts at an MFP front panel; and, accepting user commands from the UI (figure 1, item 302; column 4, lines 15-19).

Pentecost and Tanaka are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Tanaka to add a UI to an MFP. The motivation for doing so would have been for an "operator" to "set parameters" (Column 4, lines 16-17). Therefore it would have been obvious to combine Pentecost with Tanaka to obtain the invention as specified by claims 12 and 27.

13) Regarding claims 15 and 30, Pentecost teaches the method of claim 1 wherein accepting an overlay message includes accepting an overlay message from an interface.

Pentecost does not specifically teach an interface selected from the group including a scanner, stylus, smart card, virtual keyboard, and wireless personal digital assistant (PDA) interface.

Tanaka teaches an interface selected from the group including a scanner, stylus, smart card, virtual keyboard, and wireless personal digital assistant (PDA) interface (column 3, lines 20-27; figure 1).

Pentecost and Tanaka are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Tanaka to add a scanner to an MFP. The motivation for doing so would have been to input data. Therefore it would have been obvious to combine Pentecost with Tanaka to obtain the invention as specified by claims 15 and 30.

14) Claims 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,919,967 by Pentecost et al., and further in view of U.S. patent 5,959,743 by Tanaka, and further in view of U.S. patent 7,126,704 by Miura et al.

15) Regarding claims 13 and 28, Pentecost does not specifically teach the method of claim 10 wherein accepting position commands for positioning the overlay message with respect to the document includes: on an MFP display, presenting an image of the document; using a UI associated with the display, supplying prompts for superimposing the overlay message on the document; receiving user commands on the UI; positioning the overlay message in response to the commands.

Miura teaches the method of claim 10 wherein accepting position commands for positioning the overlay message with respect to the document includes: on a display, presenting an image of the document (column 11, lines 52-60); using a UI associated with the display, supplying prompts for superimposing the overlay message on the document; receiving user commands on the UI; positioning the overlay message in response to the commands (column 12, lines 11-45).

Pentecost and Miura are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Miura to add altering merge data on a display. The motivation for doing so would have been to be able to preview user actions.

Tanaka teaches an MFP display (figure 1, item 302).

Pentecost and Tanaka are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Tanaka to add an MFP display device. The motivation for doing so would have been to allow an operator to "set parameters .. and provide commands" (column 4, lines 16-19).

Therefore it would have been obvious to combine Pentecost with Miura and Tanaka to obtain the invention as specified by claims 13 and 28.

16) Claims 14, 16, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,919,967 by Pentecost et al., and further in view of U.S. patent 5,959,743 by Tanaka, and further in view of U.S. patent 6,538,623 by Parnian et al.

17) Regarding claims 14 and 29, Pentecost teaches the method of claim 1 wherein accepting an overlay message includes: from an MFP controller; converting the ASCII code to a PDL file; and, generating a rasterized overlay message (column 8, lines 53-54).

Pentecost does not specifically teach receiving an ASCII code timestamp, including a date and time.

Parnian teaches receiving an ASCII code timestamp, including a date and time (column 36, lines 15-62).

Pentecost and Parnian are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Parnian to add timestamps. The motivation for doing so would have been to know when a modification is made (column 8, line 62). Therefore it would have been obvious to combine Pentecost with Parnian to obtain the invention as specified by claims 14 and 29.

18) Regarding claims 16 and 31, Pentecost does not specifically teach the method of claim 1 further comprising: generating dynamic data selected from the group including document page count, timestamp, MFP name, and MFP identification (ID); and, wherein merging the overlay message with the document includes additionally merging the dynamic data with the document.

Parnian teaches the method of claim 1 further comprising: generating dynamic data selected from the group including document page count, timestamp, MFP name, and MFP identification (ID); and, wherein merging the overlay message with the document includes additionally merging the dynamic data with the document (column 36, lines 15-62).

Pentecost and Parnian are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Parnian to add timestamps. The motivation for doing so would have been to know when a modification is made (column

8, line 62). Therefore it would have been obvious to combine Pentecost with Parnian to obtain the invention as specified by claims 16 and 31.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **BENJAMIN O. DULANEY** whose telephone number is (571)272-2874. The examiner can normally be reached on **Monday - Friday (10am - 6pm)**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin O Dulaney/

Examiner, Art Unit 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625